

**IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF IOWA  
CEDAR RAPIDS DIVISION**

JON E. KINZENBAW and KINZE  
MANUFACTURING, INC.,

Plaintiffs/Counterclaim-  
Defendants,

vs.

CASE, LLC, f/k/a CASE  
CORPORATION and NEW HOLLAND  
NORTH AMERICA, INC.,

Defendants/Counterclaim-  
Plaintiffs.

No. C01-133-LRR

**FINAL JURY INSTRUCTIONS**

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## **INSTRUCTION NO. 1**

Members of the jury, the instructions I gave at the beginning of the trial and during the trial remain in effect. I now give you some additional instructions.

You must, of course, continue to follow the instructions I gave you earlier, as well as those I give you now. You must not single out some instructions and ignore others, because all are important. This is true even though some of those I gave you at the beginning of trial are not repeated here.

The instructions I am about to give you now are in writing and will be available to you in the jury room. I emphasize, however, that this does not mean they are more important than my earlier instructions. Again, all instructions, whenever given and whether in writing or not, must be followed.

## **INSTRUCTION NO. 2**

Neither in these instructions nor in any ruling, action or remark that I have made during the course of this trial have I intended to give any opinion or suggestion as to what your verdict should be.

### INSTRUCTION NO. 3

I have mentioned the word “evidence.” The “evidence” in this case consists of the following: the testimony of the witnesses; the documents and other things received as exhibits.

You may use reason and common sense to draw deductions or conclusions from facts which have been established by the evidence in the case.

Certain things are not evidence. I shall list those things again for you now:

1. Statements, arguments, questions, and comments by the lawyers are not evidence.
2. Exhibits that are identified by a party but not offered or received in evidence are not evidence.
3. Objections are not evidence. The parties have a right to object when they believe something is improper. You should not be influenced by the objection. If I sustained an objection to a question, you must ignore the question and must not try to guess what the answer might have been.
4. Testimony that I struck from the record, or told you to disregard, is not evidence and must not be considered.
5. Anything you saw or heard about this case outside the courtroom is not evidence.

Some of you may have heard the terms “direct evidence” and “circumstantial evidence.” You are instructed that you should not be concerned with those terms, since the law makes no distinction between the weight to be given to direct and circumstantial evidence.

#### **INSTRUCTION NO. 4**

Testimony from depositions was introduced into evidence. A deposition is testimony taken under oath before the trial and preserved in writing and sometimes on video tape. Consider deposition testimony as if it had been given in court.



## **INSTRUCTION NO. 5**

In deciding what the facts are, you may have to decide what testimony you believe and what testimony you do not believe. You may believe all of what a witness said, or only part of it, or none of it.

In deciding what testimony to believe, you may consider a witness' intelligence, the opportunity a witness had to see or hear the things testified about, a witness' memory, any motives a witness may have for testifying a certain way, the manner of a witness while testifying, whether a witness said something different at an earlier time, the general reasonableness of the testimony, and the extent to which the testimony is consistent with any evidence that you believe.

In deciding whether or not to believe a witness, keep in mind that people sometimes hear or see things differently and sometimes forget things. You need to consider therefore whether a contradiction is an innocent misrecollection or lapse of memory or an intentional falsehood, and that may depend on whether it has to do with an important fact or only a small detail.

## **INSTRUCTION NO. 6**

In the prior instruction, I instructed you generally on the credibility of witnesses. However, I must now give you some further instructions on how the credibility of witnesses can be “impeached.”

Any witness may be discredited or “impeached” by contradictory evidence; by a showing that the witness testified falsely concerning a material matter; or by evidence that at some other time the witness has said or done something, or has failed to say or do something, that is inconsistent with the witness’s present testimony. If earlier statements of a witness were admitted into evidence, they were not admitted to prove that the contents of those statements were true. Instead, you may consider those earlier statements only to determine whether you think they are consistent or inconsistent with the trial testimony of the witness, and, therefore, whether they affect the credibility of that witness.

If you believe that a witness has been discredited or impeached, it is your exclusive right to give that witness’ testimony whatever weight you think it deserves.

## **INSTRUCTION NO. 7**

You have heard testimony from persons described as experts. Persons who have become experts in a field because of their education and experience may give their opinion on matters in that field and the reasons for their opinion.

Consider expert testimony just like any other testimony. You may accept it or reject it. You may give it as much weight as you think it deserves, considering the witness' education and experience, the reasons given for the opinion, and all the other evidence in the case.

## **INSTRUCTION NO. 8**

An expert witness was asked to assume certain facts were true and to give an opinion based on that assumption. This is called a hypothetical question. If any fact assumed in the question has not been proved by the evidence, you should decide if that omission affects the value of the opinion.

## **INSTRUCTION NO. 9**

In these instructions you are told that your verdict depends on whether you find certain facts have been proved. The burden of proving a fact is upon the party whose claim or defense depends upon that fact.

In a patent case such as this, there are two different burdens of proof that are used.

The first standard of proof applicable in this case is proof by the “preponderance of the evidence.” A party with the burden to prove something by the “preponderance of the evidence” must prove that it is more likely true than not true.

The second standard of proof applicable in this case is proof by “clear and convincing evidence,” which is a higher burden of proof than “preponderance of the evidence.” A party with the burden to prove something by “clear and convincing evidence” must prove that it is highly probable that what the party seeks to prove is true.

## **INSTRUCTION NO. 10**

I will now review for you the parties in this action and the positions of the parties that you will have to consider in reaching your verdict

The plaintiffs are Jon E. Kinzenbaw and Kinze Manufacturing, Inc. They will sometimes be jointly referred to as “Kinze.”

The defendant is CNH America, LLC, formerly known as Case Corporation and New Holland North America, Inc. It will be referred to as “Case.”

Kinze contends that Case infringes United States Patent No. 4,721,168 by making, using, selling, and offering for sale Case's Model 1200 PT planter and New Holland's Model SP 580 planter. The patent has been referred to as the '168 patent. Kinze contends that Case's planters infringe claims 1, 2, 3, 9 and 22 of the '168 patent. Kinze contends that it is entitled to damages caused by Case's infringement.

Case contends that the Model 1200 PT planter and the Model SP 580 planter do not infringe the '168 patent. Case also contends that claims 1, 2, 3, 9 and 22 of the '168 patent are invalid.

## **INSTRUCTION NO. 11**

The issues in this case are:

1. Do Case's Model 1200 PT planter and Model SP 580 planter infringe one or more of the following claims of the '168 patent: 1, 2, 3, 9 and 22?

Kinze has the burden of proving infringement by the preponderance of the evidence.

2. If Case's Model 1200 PT planter and Model SP 580 planter infringe any valid claim of the '168 patent, what are Kinze's damages caused by that infringement?

Kinze has the burden of proving damages by the preponderance of the evidence.

3. If Case infringes any valid claim of the '168 patent, was the infringement willful?

Kinze has the burden of proving willful infringement by clear and convincing evidence.

4. Has Case proved that any of claims 1, 2, 3, 9 and 22 are invalid?

Case has the burden of proving invalidity by clear and convincing evidence.

## **INSTRUCTION NO. 12**

As I told you at the beginning of the trial, the claims of a patent are the numbered sentences at the end of the patent. The claims describe the invention made by the inventor and describe what the patent owner owns and what the patent owner may prevent others from doing.

Claims are usually divided into parts or steps, called "limitations". For example, a claim that covers the invention of a table may recite the tabletop, four legs and the glue that secures the legs to the tabletop. The tabletop, legs and glue are each a separate limitation of the claim.

Before you decide whether or not CASE has infringed one or more of the claims of Kinze's patent or whether or not Kinze's patent is valid, you will have to understand the patent "claims." As I mentioned previously, the patent claims involved here are claims 1, 2, 3, 9 and 22, beginning at column 18, line 45, of the '168 patent, which is exhibit PX-1 in evidence. The claims are "word pictures" intended to define, in words, the boundaries of the invention described and illustrated in the patent. Only the claims of the patent can be infringed. The Background, the Summary of the Invention, the Brief Description of the Drawing, the Detailed Description of the Illustrated Embodiment and the Drawings cannot be infringed.



### **INSTRUCTION NO. 13**

To decide the questions of infringement and validity, you must first understand what the claims of the patent cover, that is, what they prevent anyone else from doing. You must use the same claim meaning for both your decision on infringement and your decision on validity.

In this case, Case and Kinze agree about the meaning of several parts of the claims. Case and Kinze do not agree about the meaning of other parts of the claims. It is my duty to interpret these contested words and groups of words for you.

It is my job as Judge to determine what the patent claims mean and to instruct you about that meaning. You must accept the meanings I give you and use them when you decide whether or not the patent is infringed, and whether or not it is invalid.

Before I instruct you about the meaning of the words of the claims, I will explain to you the different types of claims that are at issue in this case.

It may be helpful to refer to the copy of the '168 patent that you have been given as I discuss the claims at issue here. The claims are at the end of the '168 patent, starting in column 18, line 45.

## **INSTRUCTION NO. 14**

Patent claims may exist in two forms, referred to as “independent claims” and “dependent claims.”

An independent claim does not refer to any other claim of the patent. Thus it is not necessary to look at any other claim to determine what an independent claim covers. Claims 1 and 22 of the '168 patent are independent claims.

A dependent claim refers to at least one other claim in the patent. A dependent claim includes each of the limitations of the other claim or claims to which it refers, as well as the additional limitations recited in the dependent claim itself. Therefore, to determine what a dependent claim covers, it is necessary to look at both the dependent claim and the other claim or claims to which it refers. Claims 2, 3, and 9 of the '168 patent are dependent claims. To determine what these dependent claims cover, the words of the claim you are considering and the words of the claim from which that claim depends must be read together.

## **INSTRUCTION NO. 15**

In some instances, a patent claim limitation may describe a “means” for performing a function, rather than describing the structure that performs the function. For example, let’s say that a patent describes a table in which the legs are glued to the tabletop. One way to claim the table is to recite the tabletop, four legs and glue between the legs and the tabletop. Another way to claim the table is to recite the tabletop and the legs, but rather than recite the glue, recite a “means for securing the legs to the tabletop.” This second type of claim limitation is called a “means-plus-function” limitation. It describes a means for performing the function of securing the legs to the tabletop, rather than expressly reciting the glue. Another example of a means-plus-function limitation is the “draft tongue means” element of claims 1 and 22 of the ‘168 patent.

When a claim limitation is in means-plus-function form, it covers the structures described in the patent specification for performing the function stated in the claim, and also any structure that is equivalent to the described structures. In our example, the claim covers a table using glue to secure the legs to the tabletop, as described in the patent, and any equivalent structure that performs the function of securing the legs to the tabletop.

In instructing you about the meaning of a means-plus-function claim limitation, I will tell you, first, the function that each of the means-plus-function claim limitations performs; and second, the structure disclosed in the patent specification that corresponds to each means-plus-function limitation.

## **INSTRUCTION NO. 16**

The beginning portion, or preamble, of claims 1 and 22 of the '168 patent uses the word “comprising”. “Comprising” means “including” or “containing”. A claim that uses the word “comprising” or “comprises” is not limited to products having only the elements that are recited in the claim, but also covers products that add additional elements.

Let’s take our example of the claim that covers a table. If the claim recites a table “comprising” a tabletop, legs and glue, the claim will cover any table that contains these structures, even if the table also contains other structures, such as a leaf or wheels on the legs.

## **INSTRUCTION NO. 17**

I have now instructed you as to the types of claims at issue in this case. The attached table shows the meaning of the words used in the patent claims at issue. You must use these definitions in your consideration of infringement and invalidity issues.

## **INSTRUCTION NO. 18**

A patent owner has the right to stop others from using the invention covered by its patent claims during the life of the patent. If any person makes, uses, sells or offers to sell what is covered by the patent claims without the patent owner's permission, that person is said to infringe the patent.

In reaching your decision on infringement, keep in mind that only the claims of a patent can be infringed. You must compare the claims of the '168 patent, as I have defined them, to the accused planters, and determine whether or not there is infringement. You should not compare Case's planters with any specific example set out in the '168 patent, or with Kinze's planter. The only correct comparison is with the language of the claim itself, as I have explained its meaning to you.

You must consider each claim individually and must reach your decision as to each assertion of infringement based on my instructions about the meaning and scope of the claims, the legal requirements for infringement, and the evidence presented to you by the parties.

In this case, Kinze asserts that Case's planters directly infringe claims 1, 2, 3, 9 and 22 of the '168 patent. It is your job to determine whether or not Kinze has proved by the preponderance of the evidence that Case has infringed one or more of those claims of the '168 patent.

## **INSTRUCTION NO. 19**

In order to literally infringe a patent claim, a product must include every limitation of the claim. If Case's planters omit even a single structure recited in a claim, then you must find that Case has not infringed that claim. You must consider each of the '168 patent claims separately.

## **INSTRUCTION NO. 20**

The patent law places certain limits on the scope of structural equivalents. You must use my instruction in considering both infringement and invalidity.

One limit on the scope of structural equivalents occurs as the result of changes to the patent claims or arguments that the patent owner made in order to obtain his or her patent. A patent owner may not include within the patent claims products that he or she gave up in order to obtain his or her patent.

The patent law places certain limits on claim scope that a patentee may assert after making arguments to the U.S. Patent and Trademark Office to convince the Examiner to allow claims. You must use my instruction in considering both infringement and invalidity.



## **INSTRUCTION NO. 21**

As I told you, a means-plus-function claim limitation describes a means for performing a particular function. To prove that an accused product includes a structure that is covered by a means-plus-function limitation, a patent owner must prove two things by the preponderance of the evidence: first, that the accused product contains a structure that performs the identical function to the function recited in the means-plus-function limitation; and second, that the structure of the accused product that performs that function is either identical or equivalent to the corresponding structure disclosed in the patent specification.

Whether or not the structure of the accused product is equivalent to the structure disclosed in the patent is decided from the perspective of a person of ordinary skill in the field of the invention. A person of ordinary skill is a person of average education and training in the field. A structure is equivalent if such an ordinary skilled person would consider the differences between the accused structure and the structure in the patent to be insubstantial.

One way of determining whether the structure of the accused product is equivalent to the structure disclosed in the specification is to determine whether or not persons of ordinary skill in the field of the invention believe that the structure disclosed in the specification and the structure of the accused product are interchangeable. Another way is to determine whether or not the accused structure performs the identical function, in substantially the same way, to achieve substantially the same result.

Let's go back to our example of the claim reciting three limitations – first, a tabletop, second, legs and third, a means for securing the legs to the tabletop. The third limitation is the means-plus-function portion of the claim. The patent in our example discloses glue to secure the legs to the tabletop. Let's assume that the accused device uses

**(continued)**

## **INSTRUCTION NO. 21 (continued)**

nails. They both perform the claimed function of securing the legs to the tabletop. The fact that nails and glue are different does not mean that, under the patent laws, they may not be equivalent. Whether or not they are equivalent depends on such things as whether the glue is important to the invention claimed in the patent, whether those skilled in the art of table-making would consider the glue and nails to be interchangeable, and whether in the patent or prosecution history the two are referred to as equivalent.

## **INSTRUCTION NO. 22**

My instructions on infringement so far have related to independent claims. As I told you, the '168 patent also contains dependent claims. A dependent claim includes each of the limitations of the independent claim to which it refers, plus additional elements.

If you find that independent claim 1 of the '168 patent has been infringed, you must separately determine whether dependent claims 2, 3 and 9 have also been infringed. If you find that the independent claims are not infringed, then you must also find that the dependent claims are not infringed.

### **INSTRUCTION NO. 23**

Case has presented evidence that Case obtained United States Patent No. 6,213,034 for its Model 1200 PT planter and Model SP 580 planter accused of infringement. Case has presented evidence that Case's accused planters represent an improvement of the invention described in the '168 patent claims. Proof of this fact does not necessarily mean that the accused planters do not infringe Kinze's patent claims. The tests for infringement remain as I have instructed you. As long as you find that Case's Model 1200 PT planter and Model SP 580 planter include all of the limitations of at least one of the '168 patent claims, then you must find that the '168 patent claims are infringed by Case's Model 1200 PT and Model SP 580 planters, despite Case's improvements.

## **INSTRUCTION NO. 24**

Kinze also contends that Case has willfully infringed the '168 patent claims. If you find on the basis of the evidence and the law as I have explained it, that Case infringes at least one claim of the '168 patent, you must then decide whether or not Case's infringement was willful.

When a corporation becomes aware that a patent may have relevance to its activities, that corporation has a duty to exercise due care and investigate whether or not its activities or proposed activities infringe any valid, enforceable claim of the patent. If the corporation did not do this and is found to have infringed the patent claims, then the infringement was willful.

The determination of whether Case's infringement was willful will not affect the amount of monetary damages, if any, that you will assess. The issue of willful infringement is not relevant to your decision of whether or not there is infringement. Rather, a finding of willful infringement may, in certain circumstances, entitle the patent owner to increased damages. If you decide that Case willfully infringed the '168 patent claims, then it is my job to decide whether or not to award increased damages to Kinze.

Although, as I explained before, Kinze must prove infringement by the preponderance of the evidence, Kinze must prove the infringement was willful by clear and convincing evidence.

To establish willful infringement, Kinze must prove two things by clear and convincing evidence. First, Kinze must prove that Case was aware of the '168 patent. Second, Kinze must prove that Case proceeded with the activities that are accused of infringement without a good faith belief that the patent was either invalid, not infringed, or both.

**(continued)**

## **INSTRUCTION NO. 24 (continued)**

In determining whether or not Case acted in good faith, you should consider all of the evidence presented during the course of this trial.

One of the factors you should consider is whether or not Case obtained and followed the competent advice of a lawyer. Although the absence of a lawyer's opinion does not require you to find willfulness, the obtaining and following of a lawyer's advice may be evidence that infringement was not willful. In evaluating Case's reliance on the advice of a lawyer, you should consider when Case obtained the advice, the quality of the information Case provided to the lawyer, the competence of the lawyer's opinion, and whether or not Case relied upon the advice. Advice is competent if it was based upon a reasonable examination of the facts and law relating to validity and/or infringement issues, consistent with the standards and practices generally followed by competent lawyers.

The fact that you may have determined that Case was wrong and that the '168 patent is infringed does not mean that Case's infringement was willful. All that is required to avoid a finding of willful infringement is that Case had a good faith belief that it did not infringe or that the patent was invalid, and that Case's belief was reasonable under all of the circumstances.

## **INSTRUCTION NO. 25**

Whether or not you find that the patent-in-suit is infringed, you must also determine whether the patent is invalid.

All patents issued by the United States Patent Office are presumed to be valid. Therefore, Case as the patent challenger has the burden of proving invalidity by clear and convincing evidence. However, this burden can be more easily carried out when additional evidence is introduced at trial that was not before the United States Patent Office examiner during the examination of the application for the patent-in-suit.

Only a valid patent may be infringed. For a patent to be valid, the invention claimed in the patent must be new, useful and non-obvious. A patent cannot take away from people their right to use what was known or what would have been obvious when the invention was made. The terms “new,” “useful” and “non-obvious” have special meanings under the patent laws. I will explain these terms to you as we discuss Case's grounds for asserting invalidity.

The invention claimed in a patent must also be adequately described. In return for the right to exclude others from making, using, selling or offering for sale the claimed invention, the patent owner must provide the public with a complete description in the patent of the invention and how to make and use it.

Case has challenged the validity of the '168 patent claims on a number of grounds. Case must prove that a patent claim is invalid by clear and convincing evidence.

I will now explain to you each of Case's grounds for invalidity in detail. In making your determination as to invalidity, you should consider each ground of invalidity separately.

## **INSTRUCTION NO. 26**

Case relies on certain items of prior art in its defense to infringement of claims 1, 2, 3, 9 and 22 of the '168 Patent. Under the patent laws, a person is entitled to a patent only if the invention claimed in the patent is new and unobvious in light of what came before. That which came before is referred to as the "prior art."

Case must prove by clear and convincing evidence that the prior art invalidates one or more of claims 1, 2, 3, 9 and 22 of the '168 Patent.



## **INSTRUCTION NO. 27**

A person cannot obtain a patent on an invention if someone else has already made the same invention. In other words, the invention must be new. If an invention is not new, we say that it was “anticipated” by the prior art. An invention that is “anticipated” by the prior art is not entitled to patent protection. A party challenging the validity of a patent must prove anticipation by clear and convincing evidence.

In order for a patent claim to be anticipated by the prior art, each and every limitation of the claim must be present within a single item of prior art, whether that prior art is a publication, a prior patent, a prior invention, a prior public use or sale, or some other item of prior art. You may not find that the prior art anticipates a patent claim by combining two or more items of prior art.

A printed publication or patent will not be an anticipation unless it contains a description of the invention covered by the patent claims that is sufficiently detailed to teach a skilled person how to make and use the invention without undue experimentation. That means that a person skilled in the field of the invention reading the printed publication or patent would be able to make and use the invention using only an amount of experimentation that is appropriate for the complexity of the field of the invention and for the level of expertise and knowledge of persons skilled in that field.

In deciding whether or not a single item of prior art anticipates a patent claim, you should consider that which is expressly stated or present in the item of prior art, and also that which is inherently present. Something is inherent in an item of prior art if it is always present in the prior art or always results from the practice of the prior art, and if a skilled person would understand that to be the case.

A prior public use by another may anticipate a patent claim, even if the use was

**(continued)**

## **INSTRUCTION NO. 27 (continued)**

accidental or was not appreciated by the other person. Thus, a prior public use may anticipate an invention even if the user did not intend to use the invention, or even realize he or she had done so.

In this case, CASE contends that claims 1, 2, 3, 9 and 22 are anticipated by prior art U.S. Patent 4,286,918 to Shannon (DX-173). Case further contends that claims 1, 2, 3, 9 and 22 are separately anticipated by the prior art machine known as the Turn-A-Haul machine (DX-970). If you find that CASE has proved by clear and convincing evidence that one or more of these claims are anticipated, then you must find that those claims are invalid.

## **INSTRUCTION NO. 28**

As I mentioned earlier, an inventor is not entitled to a patent if his or her invention would have been obvious to a person of ordinary skill in the field of the invention at the time the invention was made. Case contends that the asserted claims of the '168 patent are invalid for obviousness to the extent they are not anticipated.

Unlike anticipation, obviousness may be shown by considering more than one item of prior art. The question is, would it have been obvious for a skilled person who knew of the prior art to make the claimed invention? If the answer to that question is yes, then the patent claims are invalid. Case has the burden of proving by clear and convincing evidence that the claims of the '168 patent are invalid for obviousness.

Specifically, Case contends that, to the extent that any of asserted claims 1, 2, 3, 9 and 22 is not fully anticipated by prior art U.S. Patent 4,286,918 to Shannon or the prior art Turn-A-Haul machine, such claim would have been obvious to one of ordinary skill in the field of the invention in view of U.S. Patent 4,286,918 to Shannon or the prior art Turn-A-Haul machine combined with one of U.S. Patent No. 3,727,698 to Van Selus (DX-118), U.S. Patent No. 4,137,852 to Pratt (DX-98), U.S. Patent No. 4,319,643 to Carter et al. (DX-436), U.S. Patent No. 4,518,046 to Rettig et al. (DX-97), Polish Publication No. 36403 to Skive (DX-395), German Patent No. 912 875 to Kuxmann et al. (DX-394), or German Publication No. 3,150,335 to Kogel (DX-121).

Obviousness is determined from the perspective of a person of ordinary skill in the field of the invention. The issue is not whether the claimed invention would have been obvious to you, to me as a judge, or to a genius in the field of the invention. Rather, the question is whether or not the invention would have been obvious to a person of ordinary skill in the field of the invention.

**(continued)**

## **INSTRUCTION NO. 28 (continued)**

In deciding obviousness, you must avoid using hindsight; that is, you should not consider what is known today or what was learned from the teachings of the patent. You should not use the patent as a road map for selecting and combining items of prior art. You must put yourself in the place of a person of ordinary skill in the field of the invention at the time the invention was made.

You must also keep in mind that the test for obviousness is not whether or not it would have been obvious to try to make the invention, but rather whether or not the invention would have been obvious to a person of ordinary skill in the inventor's field at the time the invention was made.

In determining whether or not these claims would have been obvious, you should make the following determinations:

1. What is the scope and content of the prior art?
2. What differences, if any, are there between the invention of the claims of the patent and the prior art?
3. What was the level of ordinary skill in the art at the time the invention was made?
4. Are there any objective indications of non-obviousness?

Against this background, you must decide whether or not the invention covered by the '168 patent claims would have been obvious.

I will now describe in more detail the specific determinations you must make in deciding whether or not the claimed invention would have been obvious.

## **INSTRUCTION NO. 29**

Determining the scope and content of the prior art means that you should determine what is disclosed in the prior art relied on by Case. You must decide whether this prior art was reasonably relevant to the particular problem the inventor faced in making the invention covered by the patent claims. Such relevant prior art includes prior art in the field of the invention, and also prior art from other fields that a person of ordinary skill in the field of the invention would look to when attempting to solve the problem.

### **INSTRUCTION NO. 30**

In determining the differences between the invention covered by the patent claims and the prior art, you should not look at the individual differences in isolation. You must consider the claimed invention as a whole and determine whether or not it would have been obvious in light of all of the prior art.

In deciding whether to combine what is described in various items of prior art, you should keep in mind that there must be some motivation or suggestion for a skilled person to make the combination covered by the patent claims. You should also consider whether or not the prior art “teaches away” from the invention covered by the patent claims. The question to be answered is: Would someone reading the prior art be discouraged from following the path taken by the inventor?

## **INSTRUCTION NO. 31**

Obviousness is determined from the perspective of a person of ordinary skill in the field of the invention. This person is presumed to know all of the prior art, not just what the inventor may have known. When faced with a problem, this ordinary skilled person is able to apply his or her experience and ability to the problem and also to look to any available prior art to help solve the problem.

Factors to consider in determining the level of ordinary skill in the field of the invention include the educational level and experience of people working in the field, the types of problems faced by workers in the field and the solutions found to those problems, and the sophistication of the technology in the field.

## **INSTRUCTION NO. 32**

You also must consider what are referred to as objective indications of non-obviousness. Some of these indications of non-obviousness are:

1. Commercial success of products covered by the patent claims.
2. A long-felt need for the invention.
3. Failed attempts by others to make the invention
4. Copying of the invention by others in the field.
5. Unexpected results achieved by the invention
6. Praise of the invention by the infringer or others in the field.
7. The taking of licenses under the patent by others.
8. Expressions of surprise by experts and those skilled in the field of the invention at the making of the invention.
9. The patentee proceeded contrary to the accepted wisdom of the prior art.

The presence of any of these objective indications may suggest that the invention was not obvious. These objective indications are only relevant to obviousness if there is a connection, or nexus, between them and the novel feature or features covered by the patent claims. For example, commercial success is relevant to obviousness only if the success of the product is related to a feature of the patent claims. If the commercial success is the result of something else, such as innovative marketing, and not to a patented feature, then you should not consider it to be an indication of non-obviousness. Although you must consider any evidence of these considerations, the importance of any of them to your decision on whether the claimed invention would have been obvious, is up to you.



### **INSTRUCTION NO. 33**

Case contends that the invention claimed in claims 1, 2, 3, 9 and 22 of the '168 patent would have been obvious to a person of ordinary skill in the field of the invention at the time the invention was made. If you find that Case has proved obviousness of a particular claim by clear and convincing evidence, then you must find that the claim under consideration is invalid for obviousness.

## **INSTRUCTION NO. 34**

The patent laws have requirements for the way in which patent claims are written. Patent claims must be sufficiently clear that a person of ordinary skill in the field of the invention reading them is able to determine what the claims cover and what they do not cover. A person of ordinary skill is a person of average education and training in the field. If a patent claim does not meet this requirement, then the claim is said to be indefinite, and the claim is invalid.

The amount of detail required for a claim to be definite depends on the particular invention, the prior art and the description of the invention contained in the patent. A patent claim, when read along with the rest of the patent, must reasonably inform those skilled in the field of the invention what the patent claims cover. Simply because claim language may not be precise does not automatically mean that the claim is indefinite. The claim language need only be as precise as the subject matter permits.

Case contends that the claims of the '168 patent are invalid because the language of the claims is indefinite. Case contends that the claims of the '168 patent are indefinite because they use the words “substantially” and “proximate.” The use of the words “substantially” and “proximate,” or similar language, does not by itself cause the claim to be indefinite. In order to decide whether or not the use of those words renders those claims indefinite, you must consider whether or not the '168 patent provides some guidance about what is included within the claim term “substantially uniformly distributed,” “substantially on the centerline,” and “proximate the midpoint.” You must also consider whether or not a person of ordinary skill in the field of the invention reading the patent would understand what is included within those claim terms.

If you find that Case has proved by clear and convincing evidence that the claims

**(continued)**

### **INSTRUCTION NO. 34 (continued)**

of the '168 patent are indefinite because a person of ordinary skill in the field of the invention would not understand what is, and what is not, covered by the claims, you must then find that those claims are invalid.

## **INSTRUCTION NO. 35**

The written description of the invention claimed in a patent must contain enough detail to teach, or enable, persons skilled in the field of the invention to make and use the invention. This is referred to as the “enablement requirement.” If the patent does not enable a skilled person to practice the product of a patent claim, then the claim is invalid.

In considering whether or not the written description of a patent meets the enablement requirement, you must keep in mind that patents are written for persons of skill in the field of the invention. Thus, a patent need not expressly state information that skilled persons would be likely to know or could obtain.

The fact that some experimentation may be required for a skilled person to practice the claimed invention does not mean that a patent’s written description does not meet the enablement requirement. A written description is enabling so long as undue experimentation is not needed to make or use the invention. A permissible amount of experimentation is that amount that is appropriate for the complexity of the field of the invention and for the level of expertise and knowledge of persons skilled in that field.

Case contends that the claims of the '168 patent are invalid for lack of enablement. If you find that Case has proved by clear and convincing evidence that the written description in the '168 patent does not enable a person of ordinary skill in the field of the invention to make and use a product covered by any of these claims without undue experimentation, then you must find that the claim is invalid.

Enablement is tested as of the date the original patent application was first filed, which in this case is September 23, 1985.

## **INSTRUCTION NO. 36**

A patent must contain a written description of the product claimed in the patent. In order to satisfy the written description requirement, the patent must describe each and every limitation of a patent claim, although the exact words found in the claim need not be used.

Case contends that the claims of the '168 patent are invalid for lack of an adequate written description of the claimed invention. If you find that Case has proved by clear and convincing evidence that the '168 patent does not contain a written description of the invention covered by any of these claims, then you must find that the claim is invalid.

Case can meet its burden of proving that a patent claim is invalid by showing that the patent does not contain an adequate written description of the claimed invention. In the course of the prosecution of the patent application, the claims may be changed between the time the patent application is first filed and the time the patent is finally granted. An inventor may amend the claims in his or her original application or add new claims. The changes may narrow the scope of the claims in order to distinguish prior art or may broaden their scope to more fully cover the invention. The purpose of the written description requirement is to make sure that the inventor had in mind, that is, had invented at the time the original patent application was first filed, the full scope of the invention as finally claimed in the patent.

### **INSTRUCTION NO. 37**

I have now instructed you as to the law governing Kinze's claims of patent infringement and Case's claims of invalidity. If you find that Case has infringed a valid claim of the '168 patent, then you must determine what damages, if any, Case must pay to Kinze for that infringement. If, on the other hand, you find that Case has not infringed a valid, enforceable claim of the '168 patent, then Kinze is not entitled to any damages, and you should not make any findings about damages.

The fact that I am instructing you about damages does not mean that Kinze is or is not entitled to recover damages. I am expressing no opinion one way or the other. These instructions are only to guide you in case you find that Case infringed a valid, enforceable claim of the '168 patent.

### **INSTRUCTION NO. 38**

If you find that any claim of the '168 patent is both valid and infringed, then the patent owner is entitled to damages adequate to compensate for the infringement. These damages may not be less than what a reasonable royalty would be for the use made of the invention by the infringer. In determining damages, you must decide how much financial harm the patent owner has suffered by reason of the infringement. You must decide the amount of money that the patent owner would have made had the infringer not infringed. Damages are only to compensate Kinze, to put Kinze into the position it would have been in if Case had not infringed.

In arriving at an amount of damages, you cannot establish a figure by taking down the estimate of each juror as to damages and agreeing in advance that the average of those estimates shall be your award of damages. Rather, you must use your sound judgment based upon an impartial consideration of the evidence.

Remember, throughout your deliberations, you must not engage in any speculation, guess, or conjecture. You must not award damages by way of punishment or through sympathy. Your judgment must not be exercised arbitrarily, or out of sympathy or prejudice, for or against any of the parties.

## **INSTRUCTION NO. 39**

There are two types of damages for patent infringement. I will explain them to you now.

1. Lost profits. Briefly, lost profits damages compensate the patent owner for the additional profits that it would have made if the accused infringer had not infringed. You may hear this referred to as the “but for” test. (Lost profits are defined in more detail in Instruction No. 40).
2. Reasonable royalty. Generally, a reasonable royalty is defined by the patent laws as the reasonable amount that someone wanting to use the patented invention should expect to pay to the patent owner and the owner should expect to receive. A reasonable royalty is the minimum amount of damages that a patent owner may recover. (Reasonable royalty is defined in more detail in Instructions No. 41 and 42).



## **INSTRUCTION NO. 40**

Lost profit damages are the profits Kinze lost because of the infringement. They are not the profits Case made.

Kinze says that it lost profits because Case's infringement took away sales that Kinze would have made. This is called lost profits due to lost sales. Damages for “lost sales” are damages for the profits, if any, that Kinze lost because Case’s infringement took away sales that Kinze would have made. Therefore, to prove “lost sales,” Kinze must prove by the preponderance of the evidence that it would have made additional sales if Case had not made infringing sales or carried out infringing activities. You may award Kinze damages for “lost sales” only on those planters that compete with Case’s infringing planters. Kinze may not receive lost profit damages for other products or services that might be sold along with the competing product for convenience or business advantage, but that are not functionally part of the competing product.

In determining whether or not Kinze lost sales because of Case’s infringement, you should consider whether or not Kinze has proved by the preponderance of the evidence that Kinze had the manufacturing capacity and the marketing capacity to make the sales Kinze says it lost. Therefore, Kinze must prove by the preponderance of the evidence it could have made, or could have had someone else make for it, the additional products that Kinze says it could have sold but for Case’s infringement. Kinze must also prove by the preponderance of the evidence that Kinze had the capability to market and sell the additional products.

**(continued)**

## **INSTRUCTION NO. 40 (continued)**

In determining whether or not Kinze lost sales because of Case's infringement, you must consider whether or not, if Case's infringing planters were not available, some or all of the people who bought from Case would have bought a different, non-infringing planter from Case or from somebody else, rather than buy from Kinze. In deciding whether or not people who bought from Case would have bought a non-infringing product, you should consider whether or not there was such a demand for the patented aspects of the infringing planter or planters that purchasers would not have bought a non-infringing planter.

Finally, if Kinze has proved that it lost sales because of Case's infringement, then you are to find the amount of profits that Kinze lost. Kinze must prove the amount of its lost profits to a reasonable probability. The amount of lost profits damages should not include amounts that are merely speculation. However, if the reason that Kinze has difficulty proving the amount of its lost profits is because Case did not keep records or destroyed records, such as records of its sales, then you should resolve doubts as to the amount against Case.

## **INSTRUCTION NO. 41**

Kinze is also asking for damages in the amount of a reasonable royalty as an alternative to lost profits. If you find that Kinze has proved lost profits for all of Case's infringing sales, then the damages award to Kinze should be those lost profits.

If you find that Kinze has not proved that it should recover lost profits, or that it has only proved lost profits for some of Case's infringing sales, then for those infringing sales for which you do not award lost profits, you should determine the amount Kinze has proved to be a reasonable royalty.

## **INSTRUCTION NO. 42**

A royalty is an amount of money that someone pays a patent owner to be able to use the patented invention.

A reasonable royalty is the royalty that would be reasonable for the infringer to pay and for the patent owner to accept for use of a patent that they both know is valid and that the infringer wants to use.

You are to decide what a reasonable royalty would be, based on circumstances as of the time just before Case began selling or using the patented invention. You should assume that Case and Kinze knew at that time such things as the level of sales and profits that Case would make using the invention. You should also assume that Kinze was willing to grant Case a license to sell or use the patented invention and that Case was willing to pay for that license.

In deciding what is a reasonable royalty, you may consider the factors that Kinze and Case would consider in setting the amount Case should pay.

I will list for you a number of factors you may consider. This is not every possible factor, but it will give you an idea of the kinds of things to consider in setting a reasonable royalty.

1. Whether the patent owner had established a royalty for the patented invention, for example, by granting other licenses at that royalty. You should remember, however, that an established royalty may have been set before the patent was determined to be valid and infringed in court and, therefore, may not be as much as it would be if both the patent owner and the party wanting to use the patent know it is valid.

2. Royalties paid by Case or by others for patents comparable to the '168 patent.

**(continued)**

## **INSTRUCTION NO. 42 (continued)**

3. Whether or not Kinze had a policy of licensing or not licensing the patent.
4. Whether or not Kinze and Case are competitors.
5. Whether being able to use the patented invention helps in making sales of other products or services.
6. The profitability of the product made using the patent, and whether or not it is commercially successful or popular.
7. The advantages and benefits of using the patented invention over products not claimed in the '168 patent.
8. The extent of Case's use of the patented invention and the value of that use to Case.
9. Whether or not there is a portion or percentage of the profit or selling price that is customarily paid in the field of agricultural implements for use of patented inventions comparable to the inventions claimed in the '168 patent.
10. The portion of the profit that is due to the patented invention, as compared to the portion of the profit due to other factors, such as unpatented elements or unpatented manufacturing processes, or features or improvements developed by Case.
11. Expert opinions as to what would be a reasonable royalty.

### **INSTRUCTION NO. 43**

After making your findings concerning lost profits damages and reasonable royalty damages, you should arrive at a total damages amount to award to Kinze. This amount should include the amount of lost profits damages Kinze has proved. It also should include the reasonable royalty damages for that portion of the infringement for which Kinze did not prove lost profits damages.

## **INSTRUCTION NO. 44**

Throughout the trial, you have been permitted to take notes. Your notes should be used only as memory aids, and you should not give your notes precedence over your independent recollection of the evidence.

In any conflict between your notes, a fellow juror's notes, and your memory, your memory must prevail. Remember that notes sometimes contain the mental impressions of the note taker and can be used only to help you recollect what the testimony was. At the conclusion of your deliberations, your notes should be delivered to the Court Security Officer for destruction.

## INSTRUCTION NO. 45

In conducting your deliberations and returning your verdict, there are certain rules you must follow.

*First*, when you go to the jury room, you must select one of your members as your foreperson. That person will preside over your discussions and speak for you here in court.

*Second*, it is your duty, as jurors, to discuss this case with one another in the jury room. You should try to reach agreement if you can do so without violence to individual judgment, because a verdict must be unanimous.

Each of you must make your own conscientious decision, but only after you have considered all the evidence, discussed it fully with your fellow jurors, and listened to the views of your fellow jurors.

Do not be afraid to change your opinions if the discussion persuades you that you should. But do not come to a decision simply because other jurors think it is right, or simply to reach a verdict. Remember at all times that you are not partisans. You are judges – judges of the facts. Your sole interest is to seek the truth from the evidence in the case.

*Third*, if you need to communicate with me during your deliberations, you may send a note to me through the marshal or bailiff, signed by one or more jurors. I will respond as soon as possible either in writing or orally in open court. Remember that you should not tell anyone – including me – how your votes stand numerically.

*Fourth*, your verdict must be based solely on the evidence and on the law which I have given to you in my instructions. The verdict must be unanimous. Nothing I have said or done is intended to suggest what your verdict should be – that is entirely for you to decide.

*Finally*, I am giving you the verdict form. A verdict form is simply the written



notice of the decision that you reach in this case. Your verdict must be unanimous. You will take the verdict form to the jury room. When you have reached a unanimous verdict, your foreperson must complete one copy of the verdict form and sign and date it. All jurors also shall sign the verdict form indicating that the verdict is unanimous. The foreperson must bring the signed verdict form to the courtroom when it is time to announce your verdict. When you have reached a verdict, the foreperson will advise the Court Security Officer that you are ready to return to the courtroom.

**DATED** this 29th day of November, 2004.

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LINDA R. READE  
JUDGE, U. S. DISTRICT COURT  
NORTHERN DISTRICT OF IOWA